



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
|-----------------|-------------|----------------------|---------------------|------------------|

09/493,517

01/28/2000

Matthew Fuchs

OIN 1012-1

2359

22470 7590 12/11/2008  
HAYNES BEFFEL & WOLFELD LLP  
P O BOX 366  
HALF MOON BAY, CA 94019

EXAMINER

NGUYEN, MAIKHANH

ART UNIT

PAPER NUMBER

2176

MAIL DATE

DELIVERY MODE

12/11/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                                      |                                     |  |
|------------------------------|--------------------------------------|-------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>09/493,517 | <b>Applicant(s)</b><br>FUCHS ET AL. |  |
|                              | <b>Examiner</b><br>Maikhanh Nguyen   | <b>Art Unit</b><br>2176             |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on 22 September 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 14, 15, 17, 18, 20-26 and 30-37 is/are pending in the application.
- 4a) Of the above claim(s) 31-35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 14, 15, 17, 18, 20-26, 36 and 37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. This Office Action is responsive to the amendment filed 09/22/2008.

Claims 14, 15, 17, 18, 20-26, and 30-37 are currently pending in this application.

Claims 31-35 have been withdrawn from the consideration. Claims 14, 25, and 36 have been amended. Claims 14, 25, and 36 are independent claims.

Applicant is required to cancel non-elected claims 31-35 in the next response to this office action.

### **Claim Objections**

2. Claim 25 is objected to because of the following minor informalities:

Claim 25: "*the computer system*" should read "*the computer network system*".

Appropriate correction is required.

### **Double Patenting**

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent

Art Unit: 2176

the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. CIT. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Uogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 C.F.R. ' 1.321(b) would overcome an actual or provisional rejection on this ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. ' 1.78(d).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Pending claims 14, 15, 17, 18, 20-26, 30, and 36-37 remain rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 34-38 of U.S. Patent No. 6591260. Although the conflicting claims are not identical, they are not patentably distinct from each other because the differences between the claims in the instant application and the claims in U.S. Patent No. 6591260 would have been obvious to a person of ordinary skill in the art at the time the invention was made. The claim limitations appear to have been reworded, however, the scope of the invention appears to be generally the same.

## Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

*(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.*

Claims 14, 15, 17, 18, 20-26, 30, and 36-37 remain rejected under 35 U.S.C.

102(e) as being anticipated by **Meltzer** (U.S. Patent No.: 6125391 A, filed 10/16/1998).

*The applied reference has a common inventor with the instant application.*

*Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.*

**As to claim 25:**

Meltzer teaches a computer network system for processing a document instant of a markup language *[See the Abstract and Fig. 1 & associated text]*, the computer system comprising:

- means for defining a first tag, including a plurality of elements from a markup language, in a first schema in the computer network system *[see Col. 5, line 41 – Col. 6, line 45; Col. 9, line 56- Col. 10, line 45: a formal definition of a document structure, such as a XML document type definition DTD ... FIG. 2 is specified in an XML document type definition DTD, although other document definition architectures could be used, and includes interpretation information for the logical structures used in interpretation of instances of the documents. In addition, each of the transaction BIDs, input document BIDs and output document BIDs are specified according to an XML document type definitions. The XML type document is an example of a system based on parsed data that includes mark-up data and character data. Mark-up data identifies logical structures within the document and sets of character data identify the content of the logical structures];*
- means for polymorphically extending a definition of the first tag by use of a second schema residing on the computer network system *[see Col. 23,*

Art Unit: 2176

*lines 1-43 and Col. 33, lines 1-12: In the CBL, XML is extended with a schema. The extensions add strong-typing to XML elements so that content can be readily validated ... The schema also adds class-subclass hierarchies, so that information can be readily instantiated from class definitions. A laptop, for instance, can be described as a computer with additional tags for features such as display type and battery life. These and other extensions facilitate data entry, as well as automated translations between XML and traditional Object-Oriented and relational data models], the second schema defining a second tag by reference to the first tag that incorporates in the second schema the plurality of elements from the markup language and by including additional elements [see Col. 33, lines 1-12: business interface definition ... information includes data typing, such as for example the element <H3> Internet Address </H3> including the content form "url" and expressed in the data type "string." Yet other interpretation information includes mapping of codes to elements of a list, such as for example the element <H3> State </H3> including the code mapping for states in the file "COUNTRY.US.SUBENTITY"];*

- means for importing the second schema into the document instance [Col. 31, line 21- Col. 32, line 67: return a document conforming to a customized "invoice.dtd" whose definition is local. In effect, the company

Art Unit: 2176

*is promising to do business with anyone who can submit a Purchase Order that conforms to the XML specification it declares ... use these building blocks to implement the basic business forms such as those used in X12 EDI transactions as well as those used in emerging Internet standards such as OTP (Open Trading Protocol) and OBI (Open Buying on the Internet)].*

**As to claim 26:**

Meltzer teaches the markup language is XML [See the Abstract; Col. 2, line 67-Col. 3, line 45: XML].

**As to claim 30:**

Meltzer teaches means for using an extension of the first tag (*XML is extended with a schema. The extensions add strong-typing to XML elements so that content can be readily validated*), wherein the extension of the first tag is used in a location reserved for the first tag in the document instance (*one for taking orders and the other for tracking them. Each definition expresses a contract or promise to carry out a service if a valid request is submitted to the specified Web address. The Order service here requires an input document that conforms to a standard "po.dtd" Document Type Definition located in the repository, which may be local, or stored in an industry wide registry on the network. If a node can fulfill*



Art Unit: 2176

*the order, it will return a document conforming to a customized "invoice.dtd" whose definition is local. In effect, the company is promising to do business with anyone who can submit a Purchase Order that conforms to the XML specification it declares ... purchase orders typically contain the names and addresses of the buyer and seller, a set of product descriptions, and associated terms and conditions such as price and delivery dates. In Electronic Data Interchange EDI for example, the X12 850 specification is a commonly used model for purchase orders)[See Col. 31, line 13 –Col. 33, line 12].*

**As to claim 14:**

The rejection of claim 25 above is incorporated herein in full. Additionally, Meltzer teaches providing references for locating the first schema and second schema in the first electronic document [See Col. 4, lines 19-41: *A definition of the interface document includes logic structures for storing an identifier of a particular transaction and at least one of definitions and references to definitions of input and output documents for the particular transaction ... it may include pointers to a location in the repository, or elsewhere in the network, of such definitions*].

**As to claim 15:**

Meltzer teaches parsing the first electronic document [See Col. 3, line 19 – Col. 4, line 52; Col. 6, lines 29-61: *The participant parses the document according to the specification stored for a transaction to identify an input document for the*

Art Unit: 2176

*transaction], wherein the first electronic document is parsed by a parser for the markup language, the parser being stored on the server [See Col. 23, lines 51-63; Col. 82, lines 59- 67; and Fig.11 & associated text: The server parses incoming documents and invokes the appropriate services by, for example, handing off a request for product data to a catalog server or forwarding a purchase order to an ERP system. The server also handles translation tasks, mapping the information from a company's XML documents onto document formats used by trading partners and into data formats required by its legacy systems].*

**As to claim 17:**

Meltzer teaches the markup language is XML [See the Abstract and Col. 2, line 67- Col. 3, line 45: XML].

**As to claim 18:**

Meltzer teaches the first electronic document corresponds to, among other things, a purchase order [See the Abstract: purchase order].

**As to claim 20:**

Meltzer teaches accessing the second schema in a second electronic document [See Col. 3, line 63- Col. 4, line 17; Col. 5, lines 45-56; Col. 6, lines 3-12; and Col. 30, lines 37-52: access the definition of an input document for the

Art Unit: 2176

*complementary interface ... accessing elements ... definition of documents that comprise logic structures used to build interface description], wherein the second tag is used to encode the second electronic document [See Col. 4, lines 43- 64 and Col. 10, line 46-Col. 11, line 10: definitions of the input and output document comprise parsed data including character data encoding text characters, and mark-up data identifying sets of storage units according to the logical structures of the input and output documents].*

**As to claim 21:**

Meltzer teaches parsing the second electronic document wherein the second electronic document is parsed by a parser for the markup language, the parser being stored on the server [See Col. 3, line 19 – Col. 4, line 52; Col. 6, lines 29-61; and Col.8, lines 1-15: *The server operates to parse the incoming documents and invoke the appropriate services*].

**As to claim 22:**

Meltzer teaches the markup language is XML [See the Abstract; Col. 2, line 67-Col. 3, line 45: XML].

**As to claim 23:**

Meltzer teaches the second electronic document corresponds to a commercial transaction [See the Abstract; Col.1, lines 38-65: *commercial transactions*].

**As to claim 24:**

Meltzer teaches the commercial transaction is selected from, among other things, an purchase order [*See the Abstract; Col. 2, lines 45-54; Col. 7, lines 38-54: a purchase order*].

**As to claim 36:**

The rejection of claim 25 above is incorporated herein in full. Additionally, Meltzer teaches wherein an application designed to work with the first tag can process the text encoded using the second tag, when the encoding is within the scope of the first tag, without modifying the application, whereby document types and applications can evolve separately [*See Col. 10, line 29 – Col. 12, line 4: an XML document type definition DTD, although other document definition architectures could be used, and includes interpretation information for the logical structures used in interpretation of instances of the documents ... participant nodes in the network establish virtual enterprises by interconnecting business systems and services with XML encoded documents that businesses accept and generate*].

**As to claim 37:**

Meltzer teaches the first and second schema reside on separate servers.

## **Response to Arguments**

5. Applicant's arguments filed 09/22/2008 have been fully considered but they are not persuasive.

### **A. Regarding the 35 U.S.C. § 101 rejections**

Applicant has persuasively argued to overcome the rejections under 35 U.S.C. § 101. The rejections are withdrawn.

### **B. Regarding the nonobviousness-type double patenting rejections over claims 34-38 of US Patent 6591260**

Applicant's arguments are not persuasive. It is noted that Claims 34-38 of US Patent 6591260 and claims 14, 15, 17, 18, 20-26, 30, and 36-37 of the instant application claim the same subject matter. Particularly, independent claim 34 of Patent'260 appears to include all the limitations recited in independent claim 14 of the instant application.

### **C. Regarding the 35 USC § 102 (e) rejections**

#### **(i). Regarding independent claim 25**

Applicant argues that "[T]he Examiner makes no attempt (OA at 8-9) to read this passage from Meltzer '391 on the structures corresponding to

Art Unit: 2176

means for polymorphically extending a definition of an element, ***particularly the "extends statement"*** illustrated in the example on pp. 14-15. See, FIG. 2, ref 204. This ***passage is not close to reading on an extends statement.***"

In response, it is noted that the feature upon which applicant relies (i.e., ***extends statement***) is not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Applicant is reminded that claimed subject matter, not the specification is the measure of the invention. Limitations in the specification cannot be read into the claims for the purpose of avoiding the prior art. See *In re Self*, 213 USPQ 1,5 (CCPA 1982); *In re Priest*, 199 USPQ 11, 15 (CCPA 1978).

(ii). **Regarding independent claim 14**

Applicant argues in substance that the cited reference does not disclose the use of two schemas.

The Examiner disagrees. Meltzer (the discussion beginning at col.11, line 22) teaches different types of schemas.

(iii). **Regarding dependent claim 30**

Applicant argues in substance that the cited reference does not disclose “means for using an extension of the first tag, wherein the extension of the first tag is used in a location reserved for the first tag in the document instance”.

The Examiner disagrees. Meltzer’s teaching “XML is extended with a schema. The extensions add strong-typing to XML elements so that content can be readily validated), wherein the extension of the first tag is used in a location reserved for the first tag in the document instance (*one for taking orders and the other for tracking them. Each definition expresses a contract or promise to carry out a service if a valid request is submitted to the specified Web address. The Order service here requires an input document that conforms to a standard "po.dtd" Document Type Definition located in the repository, which may be local, or stored in an industry wide registry on the network. If a node can fulfill the order, it will return a document conforming to a customized "invoice.dtd" whose definition is local. In effect, the company is promising to do business with anyone who can submit a Purchase Order that conforms to the XML specification it declares ... purchase orders typically contain the names and addresses of the buyer and seller, a set of product descriptions, and associated terms and conditions such as price and delivery dates. In*

*Electronic Data Interchange EDI for example, the X12 850 specification is a commonly used model for purchase orders” [See Col. 31, line 13 –Col. 33, line 12] covers the limitations as claimed.*

(iv). **Regarding independent claim 36**

Applicant argues in substance that the cited reference does not disclose “whereby an application designed to work with the first tag can process the text encoded using the second tag ... without modifying the application, whereby document types and applications can evolve separately”.

The Examiner disagrees. Meltzer’s teaching “the service DTD schema be extended with a service type element” (see the discussion beginning at col.11, line 22) covers the limitations as claimed.

(v). **Regarding dependent claim 37**

Applicant argues in substance that the schemas are recited on separate servers.

The Examiner disagrees. Meltzer teaches the first (*a standard XML document type definition DTD in Fig.2*) and second schema (<DTD NAME="markpart.dtd"> ... *This element inherits the content model of the*



Art Unit: 2176

*party prototype and adds a business number attribute, which serves as a key for database lookup. The business number may be used as a cross-reference to/from customer id, credit limits contacts lists) reside on separate servers (For complete business integration ...the business interface definitions which tell potential trading partners what online services a company offers and which documents to use to invoke the services; and **servers** which provide the bridge to bind together the set of internal and external business services to create a trading community. The server operates to parse the incoming documents and invoke the appropriate services. Also the server according to the present invention handles the translation tasks from the format of the documents being received and transmitted, to and from the formats of the respective host systems... The whole process of building business interface definitions and enabling **servers** to manage commerce according to such descriptions is facilitated by a common business library, or repository, of information models for generic business concepts including business description primitives like companies, services and products, business forms like catalogs, purchase orders and invoices, and standard measurements, including time and date, location and classification of goods) [See Col. 7, line 55 - Col. 8, line 15].*

(vi). Regarding independent claims 15, 17, 20-24, and 26

Art Unit: 2176

Applicant did not provide arguments in substance regarding claims 15, 17, 20-24, and 26 except for citing the dependencies.

### **Conclusion**

6. The prior art made of record, listed on PTO 892 provided to Applicant is considered to have relevancy to the claimed invention. Applicant should review each identified reference carefully before responding to this office action to properly advance the case in light of the prior art.

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Art Unit: 2176

### **Contact information**

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maikhanh Nguyen whose telephone number is (571) 272-4093. The examiner can normally be reached on Monday - Friday from 9:00am – 5:30 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Doug Hutton can be reached at (571) 272-4137.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Maikhanh Nguyen/  
Examiner, Art Unit 2176

*/Doug Hutton/*  
Doug Hutton  
Supervisory Primary Examiner  
Technology Center 2100